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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/136,147	08/18/1998	JAY S. WALKER	WD2-98-041	1268

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/136,147

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

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M4

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/17/01, 1/8/02, 1/13/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 22-47 and 52-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 48-51 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 12/17/01, 1/8/02, 1/13/03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 10 and 13 appear to present scenarios in which the positively set forth step of offering (positively set forth in claim 1) is not required. However, because these dependant claims by definition include all limitations of the base claim, it is unclear whether the step of offering is a limitation or not. The claim scope is unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21, 48-51, 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlich et al (US6024288) in view of Folio 2/1/92 (Holiday gift subs up, some due to novel promotions).

Regarding claims 1-6, 20, 21, 48-51, 60-62, Gottlich et al states that it is known to issue a coupon at the POS checkout for a related item based upon an identified item currently being purchased. Gottlich et al provides examples of related products that would benefit from such incentive systems [1:65 to 2:6]. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product being a magazine subscription. It would have been obvious to have offered a coupon for a retail subscription product as described by Folio 2/1/92 (such as "get a year of NEWSWEEK for only \$10") when a related item such as a corresponding single issue is identified for purchase scanned at the point of sale. This would enable subscription incentives to be offered and targeted to single-issue purchasers of the periodical as well as provide incentives for consumers to purchase subscriptions which are not particularly selling well. Official Notice is taken that retail products are scanned using UPC barcodes to identify their prices which are stored in POS systems; outputting an offer for an existing subscription retail product is taken to include existence of its associated pricing. The scanning/processing of the single issue and the offer for its related subscription are taken to meet the "outputting an offer for a choice between the issue and the subscription." Offering a coupon for a discounted price on an existing retail subscription product is taken to be "initiating a subscription." The claims do not require selection/purchase of the subscription, yet the customer is free to purchase the subscription and provide the required subscription

information. The POS/clerk recognizing/offering the issue and/or subscription product is taken as providing an offer. A payment from the customer provides a “response” indicating a desire to accept the offer. A customer desiring to purchase the offered subscription clearly provides payment for the subscription plus any other products being purchased at that time (i.e. subscription price is added to the customer’s purchases/bill).

Regarding claims 7, 8, providing a subscribers name is taken to be providing a customer identifier. Likewise, the subscribers mailing address is taken to be subscription information corresponding to the customer identifier. Further, Official Notice is taken that it is well known to make POS purchases with a credit card and it would have been obvious to one of ordinary skill at the time of the invention to have done so with the subscription product purchase for convenience of payment. Doing so inherently provides a customer identifier (account #) and balance information which is taken to be “subscription information” – i.e. information needed to complete the subscription purchase. Applicant’s “subscription information” is quite broad as can be seen and is taken to require no more than “information.”

Regarding claims 9, 10, Gottlich et al teaches that the customer receives a (single) coupon for a related product. The combination suggested above provides a single offer based on a related product and is not taken to offer multiple related offers for a subscription during a purchase. If the system outputs an offer for a related subscription product, the POS system does not offer any more during that transaction.

Regarding claims 11-19, Official notice is taken that it is well known to establish pricing schedules based on a customer’s past history and/or loyalty or frequent buyer

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profile. It would have been obvious to one of ordinary skill at the time of the invention to have (researched via computer lookup and) discounted qualifying first-time subscribers in order to increase readership, or to reward long-time customers with discounts to maintain readership. These discounts in effect inherently "entitle" the customer to free issues, simply by charging them less. This discount is surely stored by the computer system in order to properly charge the customer. As is well known in the subscription business, it would have been obvious to one of ordinary skill at the time of the invention to have enabled subscribers to cancel their orders, either by phone or by mail. By stopping future issues, any discounts/free issues would not be subsequently sent. Further regarding the determination of previous offers/purchase, a POS clerk performing a transaction with a new customer would offer the subscription by requesting payment for the total purchase price (once) if the clerk had yet to request full payment for the transaction. Regarding claim 15, a threshold of zero is consistent with this scenario. A request for payment of total purchase price (offer) need only occur once for atypical retail transaction; the customer either pays the amount or not. Regarding the free issue, it is well known that subscription prices are cheaper than single issues, in effect inherently providing free issues. In essence, storing an indication that a customer is a subscriber is storing an indication that they are receiving at free issue(s). As is well known in the subscription business, it would have been obvious to one of ordinary skill at the time of the invention to have enabled subscribers to cancel their orders, either by phone or by mail. By stopping future issues, any discounts/free issues would not be subsequently sent.

Claim 62 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Folio 2/1/92. Official Notice is taken that it is well known to provide UPC barcodes and automated scanning at the POS in order to process a purchase transaction. It would have been obvious to one of ordinary skill at the time of the invention to have done so with a customer bringing a single issue to the cash register for purchase, in order to automate and quickly perform the transaction eliminating human error in price entry, for example. Folio 2/1/92 teaches that subscriptions can be sold as retail products. It would have been obvious to one of ordinary skill at the time of the invention for a POS clerk to have informed a single-issue purchaser of the availability of the retail-based subscriptions in order to help sell the subscription products and to provide customer service to customer who may not be aware of the existence of such subscription products. Doing so provides an offer between an issue and a subscription.

Response to Arguments

Applicant argues that examiner needs to provide a reference teaching that ringing up an item and presenting a price to pay provides presentation of an offer and that payment represents acceptance of the offer. Examiner has provided motivation whereby one of ordinary skill would find it obvious to carry out certain steps. The interpretation of how those steps meet the claim language is based on the *examiner's* broadest reasonable interpretation of the claim language. The references need not teach how to interpret applicant's claim language.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc